

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

IN RE APPLICATION OF: Baeschlin et al.

Art Unit: 1621

Examiner: Ex. Kumar

APPLICATION NO: 10/579,427

PATENT NO: 7582782

FILED: May 12, 2006

FOR: ORGANIC COMPOUNDS

MS: General  
Commissioner for Patents  
PO Box 1450  
Alexandria, VA 22313-1450

**PETITION REGARDING PATENT TERM ADJUSTMENT POST GRANT UNDER C.F.R.**  
**§1.705(d)**

Sir:

In accordance with 37 C.F.R. § 1.705(d), Applicant hereby applies for patent term adjustment under 35 U.S.C. § 154(b) of 577 days. This application is being filed within two months of the date the patent issued, as required by 37 C.F.R. § 1.705 (d).

As an initial matter, Applicants appreciate the information provided in the Office of Petitions letter dated August 03, 2009 regarding the preliminary petition for patent term adjustment filed June 12, 2009. A copy of the letter is enclosed herewith.

**I. Fee**

The Office acknowledged receipt of the petition fee of \$200.00 required by 37 C.F.R. §1.705(b)(1) in the letter dated August 03, 2009. We believe that no additional fees are required for consideration of the instant petition. However, please charge any deficiencies or any additional fees due in response to this request to Deposit Account **50-4409**.

**II. Statement of the Facts Involved**

**A. Correct Patent Term Adjustment**

The Notice of Allowance, which was mailed on March 13, 2009, indicated a preliminary Patent Term Adjustment of 465 days.

Patentee has calculated a final patent term adjustment of 577 days based on the following facts:

#### **Case Law**

In *Wyeth v. Dudas*, 2008 U.S. Dist. LEXIS 76063 (D.D.C. 2008), the District Court of the District of Columbia addressed the United States Patent and Trademark Office (USPTO) interpretation of 35 U.S.C. § 154(b)(2). The Court granted summary judgment in favor of Wyeth, determining that the USPTO misconstrued the first sentence of 35 U.S.C. § 154(b)(2)(A), and as a result, improperly denied Wyeth a portion of patent term to which Wyeth was entitled under 35 U.S.C. § 154.

In the opinion, the Court stated that "the PTO's view is that any administrative delay under § 154(b)(1)(A) overlaps any 3-year maximum pendency delay under § 154(b)(1)(B): the applicant gets credit for 'A delay' or for 'B delay,' whichever is larger, but never A + B." However, Plaintiff Wyeth argued that the § 154(b)(1)(A) and § 154(b)(1)(B) period overlap only if they occur on the same calendar day or days. The Court determined that Wyeth's construction of § 154(b)(2)(B) was correct.

Simply put, the holding of the Court is that the excluded overlap recited in the first sentence of 35 U.S.C. § 154(b)(2)(A) only occurs if a 35 U.S.C. § 154(b)(2)(A) period and a 35 U.S.C. § 154(b)(2)(B) period run concurrently. As such, a patent holder is entitled to recoup the 35 U.S.C. § 154(b)(2)(A) period that falls outside of the 35 U.S.C. § 154(b)(2)(B) period in addition to the 35 U.S.C. § 154(b)(2)(B) period itself.

#### **Relevant Dates**

The above identified application has a 35 U.S.C. §371 filing date of May 12, 2009.

A Notice of Allowance was mailed March 13, 2009.

The issue fee has been paid on June 12, 2009, within the 3 months provided by 35 U.S.C. §154(b).

Patentee agrees with the initial PTO adjustment based on delay under 35 U.S.C. § 154(b)(2)(A) of 465 days.

The 35 U.S.C. § 154(b)(2)(B) period for the instant application began on May 12, 2009 (35 U.S.C. §371 filing date) and ended on September 1, 2009 with the issuance of the instant application. The 35 U.S.C. § 154(b)(2)(B) period is 112 days. The reduction in term adjustment

due to applicant delay is 0 days, resulting in an initial patent term adjustment of 112 days under 35 U.S.C. § 154(b)(2)(B).

There was 0 days of PTO delay under 35 U.S.C. § 154(b)(2)(A) that occurred within the 35 U.S.C. § 154(b)(2)(B) period that should be excluded from the patent term adjustment calculation under the holding of *Wyeth v. Dudas*.

Accordingly, the sum of the 35 U.S.C. § 154(b)(2)(B) delay (112 days) and non-overlapping 35 U.S.C. § 154(b)(2)(A) delay (465 days) is 577 days.

The initial PTA printed on the Issue Notification is only 465 days, which the USPTO is presumed to have calculated using the method considered proper before the holding of *Wyeth v. Dudas*. Applicants therefore respectfully request reconsideration of the initial PTA calculation.

**B. Terminal Disclaimer**

The above-identified patent is not subject to a Terminal Disclaimer.

**C. Reasonable Efforts**

Any applicant delays under 37 C.F.R. § 1.704 are set forth above. There were no other circumstances constituting a failure to engage in reasonable efforts to conclude processing of examination of the above-identified application, as set forth in 37 C.F.R. § 1.704.

Respectfully submitted,

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